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DICKSTEIN SHAPIRO MORIN & OSHINSKY LLP
2101 L STREET NW
WASHINGTON, DC 20037-1526

EXAMINER

YIGDALL, MICHAEL J

ART UNIT	PAPER NUMBER
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2122

DATE MAILED: 08/26/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/783,553

Applicant(s)

SATOH, HIROTSUGU

Examiner

Michael J. Yigdal

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 24 May 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-5 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-5 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This Office action is in reply to Applicant's response and amendment dated May 24, 2004. Claims 1-5 remain pending.

Response to Arguments

2. Applicant's arguments with respect to claims 1-5 have been considered but are moot in view of the new ground(s) of rejection.

As set forth below, Otsuka discloses a rewritable optical recording medium (see FIGS. 1C and 1D) for distributing and installing application programs that may be updated in the same recording medium (see column 20, lines 28-42).

Specification

3. The title of the invention, as amended, is not descriptive. A new title is required that is clearly indicative of the invention to which the claims are directed. See MPEP § 606.01.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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5. Claims 1 and 4 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Pat. No. 6,097,814 to Mochizuki (art of record) in view of U.S. Pat. No. 6,094,723 to Otsuka (art of record).

With respect to claim 1 (currently amended), Mochizuki discloses an optical recording medium that is computer-readable and -writable (see column 5, lines 15-21, which shows a computer-readable optical recording medium; see also column 9, line 56 to column 10, line 8, which shows that the medium is writable), which medium stores software to be distributed, non-rewritable inherent ID information (see column 5, lines 29-35, which shows that the medium stores software to be distributed and inherent ID information; see also column 5, lines 56-67, which shows that the ID is permanent, i.e. non-rewritable), and a transmission program for transmitting the inherent ID information to a software distributor via a communication device (see steps S1 and S4 in FIG. 4, and column 7, lines 3-10, which shows that the ID stored on the medium is transmitted to a software distributor).

Mochizuki does not expressly disclose the limitation wherein the medium stores a program for causing updated software to be stored in a memory device of a computer and in said optical recording medium.

However, Otsuka similarly discloses an optical recording medium that is computer-readable and -writable (see FIGS. 1C and 1D, which show discs having rewritable area ARW). Otsuka further discloses that the medium stores application programs for distribution as well as additional updated software (see column 20, lines 28-36). The upgraded or updated software may be installed, i.e. stored in a memory device of a computer (see column 20, lines 37-42).

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It would have been obvious to one of ordinary skill in the art at the time the invention was made to supplement the system of Mochizuki with a program for causing updated software to be stored in a memory device of a computer and in said optical recording medium, such as taught by Otsuka, so that updates may be later added to a medium that is already recorded with application programs (see Otsuka, column 20, lines 28-36).

With respect to claim 4 (currently amended), Mochizuki further discloses storing a computer information acquiring program for acquiring information of said computer (see column 6, lines 17-30, which shows obtaining a drive ID from the reproduction apparatus that is using the medium), wherein the transmission program transmits the information of the computer, as well as the inherent ID information, to the software distributor (see steps S1, S2 and S4 in FIG. 4, and column 7, lines 3-10, which shows transmitting the inherent ID of the medium and the drive ID or information of the computer to the software distributor).

6. Claims 2, 3 and 5 are rejected under 35 U.S.C. 103(a) as being unpatentable over Mochizuki in view of Otsuka in view of U.S. Pat. No. 6,381,741 to Shaw (art of record).

With respect to claim 2 (currently amended), Mochizuki discloses an optical recording medium that is computer-readable and -writable (see column 5, lines 15-21, which shows a computer-readable optical recording medium; see also column 9, line 56 to column 10, line 8, which shows that the medium is writable), which medium stores software to be distributed and non-rewritable inherent ID information (see column 5, lines 29-35, which shows that the medium stores software to be distributed and inherent ID information; see also column 5, lines 56-67, which shows that the ID is permanent, i.e. non-rewritable).

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Although Mochizuki discloses reproducing the software based on an authentication judgment result of the inherent ID information (see steps S1, S4, S8 and S9 in FIG. 4), Mochizuki does not expressly disclose a software updating program for rewriting and updating the software in accordance with update software transmitted from a software distributor via a communication device based on an authentication judgment result of the inherent ID information.

However, Shaw discloses an updater or updating program (see column 4, lines 44-49) for rewriting and updating software with updated code transmitted from a distributor (see column 5, lines 3-13), based on an authentication judgment result (see column 4, lines 34-42, which shows comparing a digital signature before beginning the update process), after first transmitting ID information (see column 4, lines 13-18).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to supplement the system of Mochizuki with a program for rewriting and updating the software, such as taught by Shaw, for the purpose of enabling a secure update to the software before it is reproduced (see Shaw, column 1, line 66 to column 2, line 10).

Mochizuki does not expressly disclose the limitation wherein the software updating program is for causing updated software to be stored in a memory device of a computer and in said optical recording medium.

However, Otsuka similarly discloses an optical recording medium that is computer-readable and -writable (see FIGS. 1C and 1D, which show discs having rewritable area ARW). Otsuka further discloses that the medium stores application programs for distribution as well as

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additional updated software (see column 20, lines 28-36). The upgraded or updated software may be installed, i.e. stored in a memory device of a computer (see column 20, lines 37-42).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to supplement the system of Mochizuki with a program for causing updated software to be stored in a memory device of a computer and in said optical recording medium, such as taught by Otsuka, so that updates may be later added to a medium that is already recorded with application programs (see Otsuka, column 20, lines 28-36).

With respect to claim 3, Mochizuki discloses an optical recording medium that is computer-readable and -writable (see column 5, lines 15-21, which shows a computer-readable optical recording medium; see also column 9, line 56 to column 10, line 8, which shows that the medium is writable), which medium stores software to be distributed, non-rewritable inherent ID information (see column 5, lines 29-35, which shows that the medium stores software to be distributed and inherent ID information; see also column 5, lines 56-67, which shows that the ID is permanent, i.e. non-rewritable), and a transmission program for transmitting the inherent ID information to a software distributor via a communication device (see steps S1 and S4 in FIG. 4, and column 7, lines 3-10, which shows that the ID stored on the medium is transmitted to a software distributor).

Although Mochizuki discloses reproducing the software based on an authentication judgment result of the inherent ID information (see steps S1, S4, S8 and S9 in FIG. 4), Mochizuki does not expressly disclose a software updating program of rewriting and updating the software in accordance with update software transmitted from the software distributor via the

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communication device based on an authentication judgment result of the inherent ID information.

However, Shaw discloses an updater or updating program (see column 4, lines 44-49) for rewriting and updating software with updated code transmitted from a distributor (see column 5, lines 3-13), based on an authentication judgment result (see column 4, lines 34-42, which shows comparing a digital signature before beginning the update process), after first transmitting ID information (see column 4, lines 13-18).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to supplement the system of Mochizuki with a program for rewriting and updating the software, such as taught by Shaw, for the purpose of enabling a secure update to the software before it is reproduced (see Shaw, column 1, line 66 to column 2, line 10).

Mochizuki does not expressly disclose the limitation wherein the medium stores a program for causing updated software to be stored in a memory device of a computer and in said optical recording medium.

However, Otsuka similarly discloses an optical recording medium that is computer-readable and -writable (see FIGS. 1C and 1D, which show discs having rewritable area ARW). Otsuka further discloses that the medium stores application programs for distribution as well as additional updated software (see column 20, lines 28-36). The upgraded or updated software may be installed, i.e. stored in a memory device of a computer (see column 20, lines 37-42).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to supplement the system of Mochizuki with a program for causing updated software to be stored in a memory device of a computer and in said optical recording medium, such as

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taught by Otsuka, so that updates may be later added to a medium that is already recorded with application programs (see Otsuka, column 20, lines 28-36).

With respect to claim 5, Mochizuki discloses software distributed and stored in a computer-readable and -writable optical recording medium (see column 5, lines 15-21, which shows software distributed and stored in a computer-readable optical recording medium; see also column 9, line 56 to column 10, line 8, which shows that the medium is writable).

Although Mochizuki discloses a method for reproducing software (see the title and abstract), Mochizuki does not expressly disclose a method of updating software. However, Shaw discloses a method of upgrading or updating software (see the title and abstract).

Mochizuki further discloses transmitting non-rewritable inherent ID information to a software distributor via a communication device (see steps S1 and S4 in FIG. 4, and column 7, lines 3-10, which shows that the ID stored on the medium is transmitted to a software distributor).

Although Mochizuki discloses reproducing the software based on an authentication judgment result of the inherent ID information (see steps S1, S4, S8 and S9 in FIG. 4), Mochizuki does not expressly disclose rewriting and updating the software in accordance with update software transmitted from the software distributor via the communication device based on an authentication judgment result of the inherent ID information.

However, Shaw further discloses an updater or updating program (see column 4, lines 44-49) for rewriting and updating software with updated code transmitted from a distributor (see column 5, lines 3-13), based on an authentication judgment result (see column 4, lines 34-42,

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which shows comparing a digital signature before beginning the update process), after first transmitting ID information (see column 4, lines 13-18).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to supplement the method of Mochizuki with the step of rewriting and updating the software, such as taught by Shaw, for the purpose of enabling a secure update to the software before it is reproduced (see Shaw, column 1, line 66 to column 2, line 10).

Mochizuki does not expressly disclose updating software in the computer-readable and -writable optical recording medium and in a memory device of a computer that is currently using the computer-readable and -writable optical recording medium.

However, Otsuka similarly discloses an optical recording medium that is computer-readable and -writable (see FIGS. 1C and 1D, which show discs having rewritable area ARW). Otsuka further discloses that the medium stores application programs for distribution as well as additional updated software (see column 20, lines 28-36). The upgraded or updated software may be installed, i.e. stored in a memory device of a computer (see column 20, lines 37-42).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to supplement the method of Mochizuki with the step of updating software in the computer-readable and -writable optical recording medium and in a memory device of a computer that is currently using the computer-readable and -writable optical recording medium, such as taught by Otsuka, so that updates may be later added to a medium that is already recorded with application programs (see Otsuka, column 20, lines 28-36).

Conclusion

7. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael J. Yigdall whose telephone number is (703) 305-0352. The examiner can normally be reached on Monday through Friday from 7:30am to 4:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tuan Q. Dam can be reached on (703) 305-4552. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

MY

Michael J. Yigdal
Examiner
Art Unit 2122

mjy


TUAN DAM
SUPERVISORY PATENT EXAMINER